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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/558,933	04/26/2000	John F. Acres	4164-125	1655

7590

05/17/2004

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EXAMINER

HARRISON, JESSICA

ART UNIT PAPER NUMBER

3714

DATE MAILED: 05/17/2004

8

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/558,933

Applicant(s)

ACRES, JOHN F.

Examiner

Jessica J. Harrison

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 April 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 7.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Information Disclosure Statement***

The information disclosure statement filed 3/10/2004 is proper and has been considered.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 12-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Heidel (EP 0769769).

Claims 12 – 16 have not been substantively amended. Therefore, this rejection remains unchanged from the prior office action.

Heidel discloses a video gaming machine having a touch screen. The game machine includes a card reader (30), a machine communications interface (70), display (12), programmed electronics (inherent), and a video overlay device (56). The game machine is connected to a host computer (68) which includes a database of player account information such as a player name, player id, and player point totals. Figure 3 shows the division of the display screen when accessing the player tracking information from the game

machine. In column 6 of the disclosure, Heidel states "In addition, because video display 12 is under the control of a microprocessor, the system has enhanced flexibility. For example, at a touch of a suitable area (not shown) on the screen 23, service request key area 80 can be displayed from which the player can order casino services or request change without interrupting game play." Clearly, this suggests a video overlay or superimposition of data upon the play screen. Inherently this could include the information/message display are 76 as well.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 17 – 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heidel in view of Fertitta, III et al (Fert).

Claims 17-21 have not been substantively amended. Therefore, this rejection remains unchanged from the prior office action.

Heidel indicates that player tracking is included in his system without the need to retrofit the game machines with a "systems box". He eludes that tracking systems are known, and states generally "the data system tracks total wagering activity for each player so that frequent activity can be rewarded...".

He clearly shows a player name, or ID, and a point (or point session) total in his illustrative display.

Fert teaches a player tracking system which includes other known tracked data points such as a personal progressive, comp point balances, player ratings (extra credit) and bonus point balances (loyalty). In short, a designer of a system can create as many types of data fields and track activity data with an endless segregation of names and requirements as are deemed necessary to promote play and keep the player at the machine. It would have been obvious to one of ordinary skill in the art at the time of the invention to utilize known data tracking fields in the Heidel tracking system, such as those illustrated by Fert, in order to promote play, keep the player at the machine and reward frequent activity. Such is the overall intent of all player-tracking systems.

Claims 1, 2 and 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heidel (EP 0769769) in view of Found et al (PCT 97/12315) hereinafter Found.

Heidel discloses a video gaming machine having a touch screen. The game machine includes a card reader (30), a machine communications interface (70), display (12), programmed electronics (inherent), and a video overlay device (56). The game machine is connected to a host computer (68) which includes a database of player account information such as a player name, player id, and player point totals. Figure 3 shows the division of the

display screen when accessing the player tracking information from the game machine. In column 6 of the disclosure, Heidel states "In addition, because video display 12 is under the control of a microprocessor, the system has enhanced flexibility. For example, at a touch of a suitable area (not shown) on the screen 23, service request key area 80 can be displayed from which the player can order casino services or request change without interrupting game play." Clearly, this suggests a video overlay or superimposition of data upon the play screen. Inherently this could include the information/message display are 76 as well.

Heidel differs only from the present limitation of claim 1 which requires the generating the game display information in a first display electronics and generating the player account display in a second display electronics. Even though Heidel suggest the desirability of the overall claimed function of providing account information over the game screen via a drop down menu without interrupting game play, Heidel only shows one set of display electronics and does not suggest there can be any arbitrary delineation of a first set from a second set.

In an analogous game machine/display system, Found teaches the addition of a second set of display electronics expressly for the purpose of generating overlay messages to a player of the game device. The video overlay electronics are provided on a separate circuit board which is capable of being installed into a standard gaming machine. The Found system, discussed at

least on page 6, appears most applicable to displaying jackpot information yet suggests on page 13, line 20, "It will be appreciated by those skilled in the art that the arrangement (retrofittable second set of electronics for generating/superimposing) provides a convenient and flexible arrangement for superimposing video character information on the video output displays of various types of electronic gaming machines." Clearly, Found suggests the desirability of retrofitting gaming machines with a second set of display electronics for generating an overlay image of textual information.

One of ordinary skill in the art seeking to implement the Heidel teaching of providing the ability to view account information without interrupting game play would recognize the advantages suggested by the Found teaching. In particular, the provision of a second set of display electronics for creating an overlay image of the account information and the superimposing that image on a game display would allow existing games to be retrofitted with the desired functionality of Heidel without alteration to the existing graphics generation hardware/software arrangement. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide a second set of display electronics for generating the overlay information on the Heidel device in view of the structure/teachings contributed to the art by Found.

Claims 3 and 7-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heidel in view of Found as applied to claim 1 above, and further in view of Fertitta, III et al (Fert).

Heidel, as modified above by Found, indicates that player tracking is included in his system without the need to retrofit the game machines with a "systems box". He eludes that tracking systems are known, and states generally "the data system tracks total wagering activity for each player so that frequent activity can be rewarded...". He clearly shows a player name, or ID, and a point (or point session) total in his illustrative display.

Fert teaches a player tracking system which includes other known tracked data points such as a personal progressive, comp point balances, player ratings (extra credit) and bonus point balances (loyalty). In short, a designer of a system can create as many types of data fields and track activity data with an endless segregation of names and requirements as are deemed necessary to promote play and keep the player at the machine. It would have been obvious to one of ordinary skill in the art at the time of the invention to utilize known data tracking fields in the Heidel tracking system, such as those illustrated by Fert, in order to promote play, keep the player at the machine and reward frequent activity. Such is the overall intent of all player-tracking systems.

### ***Response to Arguments***

Applicant's arguments filed March 1, 2004 have been fully considered but they are not persuasive. To the extent that the arguments remain applicable given the amendments/new grounds of rejection the examiner offers the following comments to the record. First regarding the Heidel reference, applicant argues that no "overlay device" was provided and that the structure



of Heidel could not be used to retrofit. To the extent these arguments are commensurate in scope with the claim language, they have been addressed above in the rejections. Further, applicants note that to applicants knowledge, the assignee of the Heidel disclosure has never used an overlay device in industry. Respectfully, actual use or lack thereof of technology does not erase teachings of patents and printed publications from the tome of analogous prior art which one of ordinary skill in the art is presumed to have knowledge of.

Next, applicant argues regarding claim 12 that Heidel does not have "communication means for bi-directional communication between the host computer and the gaming machine...*including supplemental commands operative with said gaming electronics to combine said game image with player tracking image* generated from said player tracking information communicated from said host computer to said gaming machine." Respectfully, this is inherently within the Heidel teaching as the overall function is preformed. Heidel possess communication means at least in elements 70 and 72 which bidirectionally communicate between the host computer 68 and the gaming machine 34. Host computer 68 has a data base for storing player account data and for archiving accounting and other information. Through touch screen controller 60 and video display controller 56, CPU 34 generates touch sensitive key areas for player input and message areas for outputting information. Whatever the player selects via the touch areas or pull down menu, the host computer responds to. For example, if a casino service purchase is requested,

the host computer verifies the requested transaction and authorizes the gaming machine to proceed with the transaction. This includes player notification that the request has been accepted and therefore inherently includes supplemental commands to provide an appropriate display overlay.

Finally, with respect to claim 13 applicant submits that Heidel fails to show "a video overlay device interposed between said gaming electronics and said video game display...electronics". Respectfully note video controller 56 interposed between gaming electronics 34 and display 12 in Heidel. That applicant believes his claims to require more than the function of overlaying does not preclude the reasonable interpretation of the examiner's in that the applied prior art performs the identical function for the identical reason and therefore anticipates.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

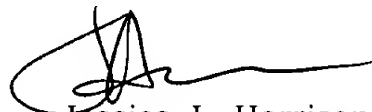
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH

shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessica J. Harrison whose telephone number is 703-308-2217. The examiner can normally be reached on 8 hour/M-F.

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.



Jessica J. Harrison  
Primary Examiner  
Art Unit 3714

jjh